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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213743
Party	Plaintiff Be Sport, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of
Trademark Application Serial No. 85/639,289
Mark: BEIN SPORT

Be Sport, Inc.,	)	
Opposer,	)	
vs.	)	Opposition No. 91213743
Al-Jazeera Satellite Channel,	)	
Applicant.	)	

OPPOSER BE SPORT, INC.'S OPPOSITION TO APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER

Applicant Al-Jazeera Satellite Channel's Motion for Leave to Amend Answer to add the affirmative defense of *res judicata* premised on the dismissal of Opposer Be Sport, Inc.'s ("Be Sport") Opposition No. 91212091 against Applicant's BEIN mark should be denied. The mark at issue here, BEIN SPORT, is sufficiently different, and conveys a distinct commercial impression, such that the defense, as a matter of law, necessarily fails. To allow such an amendment, at this late stage of the proceedings and with discovery closed, would unnecessarily and prejudicially expand these proceedings to address an ultimately futile defense.

BACKGROUND FACTS

On October 3, 2014, Applicant filed its Motion for Summary Judgment arguing that the Board's decision against Be Sport in Opposition No. 91212091, in which Be Sport opposed the application for registration of the BEIN mark, precludes Be Sport from maintaining the present Opposition under the doctrine of *res judicata*. Opposition No. 91212091 was brought by Be Sport against Applicant's application to register its BEIN mark on the basis that Be Sport's application of its BE SPORT mark has priority over Applicant's BEIN mark and that there was a

likelihood of confusion between the two marks. Applicant filed its applications for the BEIN and BEIN SPORT marks on May 31, 2012. Be Sport instituted Opposition No. 91212091 on August 19, 2013. The present Opposition was commenced on by Be Sport on November 27, 2013.

Applicant moved to involuntarily dismiss Opposition No. 91212091 on July 31, 2014. Be Sport did not oppose the dismissal and the Board dismissed Opposition No. 91212091 with prejudice on September 2, 2014. Discovery in the present Opposition closed on August 4, 2014, and Be Sport served its Pretrial Disclosures on September 18, 2014.

Although the dismissal and resulting judgment on which Applicant bases its *res judicata* defense had been entered over a month before, Applicant did not file its Motion to Amend to add the *res judicata* defense until October 3, 2014. Indeed, the Motion to Amend was only made after the Board rejected Applicant's Motion for Summary Judgment on the basis that the *res judicata* defense had not been pled in Applicant's Answer. Applicant then refiled its Motion for Summary Judgment as well as the present Motion to Amend Answer.[1]

APPLICANT'S PROPOSED RES JUDICATA DEFENSE IS FUTILE SUCH THAT LEAVE TO AMEND SHOULD BE DENIED

Applicant's motion to amend its answer to plead a defense of *res judicata* should be denied as futile. Although leave to amend is liberally granted pursuant to Federal Rule of Civil Procedure 15(a) and Trademark Rule 2.107(a), such leave is not without limits and may be denied where the proposed claims or defenses are futile. *See, e.g., Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp*. 94 U.S.P.Q.2d 1294, 1297, 1300 (T.T.A.B. 2010) (notwithstanding the liberal policy underlying amendments to pleadings, leave to amend answer denied where the proposed defense was futile; related motion for summary judgment also denied based on futile defense); *Institue Nat'l Des Appellations D'Origine v. Brown-Forman Corp.*, 47 U.S.P.Q.2d 1875, 1896 (T.T.A.B. 1998) (leave to amend denied as *res judicata* claim was futile). *Res judicata,* or claim preclusion, is a viable defense only in cases involving non-identical marks

[1] Be Sport opposes the Motion for Leave to Amend without prejudice to, and with, full reservation of its arguments in opposition to Applicant's pending Motion for Summary Judgment.

where the marks "create substantially the same commercial impression or where both applications constituted a single transaction or series of transactions." *Id.*

Neither situation is applicable here. The Applicant's marks at issue in this Opposition and in the prior Opposition, BEIN SPORT and BEIN, are sufficiently dissimilar as to convey differing commercial impressions. *See, e.g., id.* (denying opposer's motion for leave to amend notice of opposition as the mark in the prior Opposition, MIST AND COGNAC, created a different commercial impression than the mark at issue, CANADIAN MIST AND COGNAC); *Chromalloy Am. Corp. v. Kenneth Gordon, Ltd.*, 736 F.2d 694, 697–98 (Fed. Cir. 1984) (claim preclusion not applicable because the LADY GORDON mark was a "different mark" from the GORDON and GORDON OF NEW ORLEANS marks at issue in a prior infringement proceeding).

Although the BEIN and BEIN SPORT marks both contain "BEIN," the BEIN SPORT mark creates a distinct commercial impression. By including the word "SPORT," the mark clearly evokes sporting and athletic interests, a direct impression absent from the standalone BEIN mark. Notably, Applicant's Motion for Summary Judgment ("MSJ") fails to make any argument that its two applied for marks have the same commercial impression. Instead, Applicant contends that the "the descriptive and non-distinctive component SPORT . . . has no trademark significance whatsoever." *See* MSJ at 7. But it is well established that "[t]he disclaimed elements of a mark, however, are relevant to the assessment of similarity" given that likelihood of confusion is "evaluated from the perspective of the purchasing public." *See Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1243 (Fed. Cir. 2004) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993)).

The inclusion of the "SPORT" suffix also renders the BEIN SPORT mark far more similar in sound, look and meaning to Be Sport's own BE SPORT mark. Accordingly, the evidence of likelihood of confusion "between the opposer's mark and the applicant's first mark" would not be "identical to the evidence of likelihood of confusion between the opposer's mark and the applicant's second mark." *Institue Nat'l Des Appellations D'Origine*, 47 U.S.P.Q.2d at

1896. Indeed, preclusion is only a viable defense where the evidence of confusion would be identical. *See, e.g., Metromedia Steakhouses, Inc. v. Pondco II*, 28 U.S.P.Q.2d 1205, 1208 (T.T.A.B. 1993) (*res judicata* not applicable where the "evidence relating to the issue of likelihood of confusion with the first mark would not be precisely the same as the evidence with respect to likelihood of confusion with the second mark") (emphasis supplied). Nor does it matter that Applicant may have intended to use both marks "for the same products" or for purchasers to "use both marks to call for the product." Such intent by the applicant does not render the marks "legal equivalents creating a single commercial impression." *Institut National des Appellations d'Origine,* 47 U.S.P.Q.2d at 1895.

CONCLUSION

Given that the marks at issue in the two Oppositions are sufficiently different as to convey distinct commercial impressions, Applicant's *res judicata* defense must ultimately fail. Amendments to add futile defenses, even under Rule 15(a)'s liberal standard, should thus be denied. *See, e.g., id.* at 1896 (leave to amend denied as opposers could not prevail on *res judicata* claim as a matter of law). Additionally, should the Board deny Applicant's request for leave to amend to add a *res judicata* defense, Applicant's motion for summary judgment should be rejected and denied as improperly filed. *Am. Express. Mktg & Dev.*, 94 U.S.P.Q.2d at 1300 (after Board determined that the proposed affirmative defense was futile, the summary judgment motion based on that inapplicable defense was also denied).

DATED: October 23, 2014

Respectfully submitted,

/cle1087/

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PROOF OF SERVICE BY MAIL

I declare that:

I am employed in the County of Santa Clara, California. I am over the age of eighteen years and not a party to the within cause; my business address is Silicon Valley Center, 801 California Street, Mountain View, California 94041. On the date set forth below, I served **BE SPORT, INC.'S OPPOSITION TO APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER**, on the interested parties in this action by placing a true copy thereof in a sealed envelope with postage thereon fully prepaid, and causing it to be placed for U.S. First Class Mail delivery by the U.S. Postal Service, which envelope was addressed as follows:

Kevin G. Smith
Sughrue Mion, PLLC
2100 Pennsylvania Ave NW, Suite 800
Washington, DC 20037-3202

I declare under the penalties of perjury that the above is true and correct, and that this declaration was executed at Mountain View, California this 23rd day of October, 2014.

/Debbie Shaw/
Debbie Shaw